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In re Application of :
HIGASHI, Mitsuhiro *et al* :
Application No.: 09/555,255 :
PCT No.: PCT/JP99/05273 :
Int. Filing Date: 28 September 1999 :
Priority Date: 28 September 1998 :
Attorney Docket No.: 1155-0198P :
For: ORTHOALKYLATION CATALYST FOR :
PHENOL AND PROCESS . . .

COMMUNICATION

This communication is in response to matters arising out of 35 U.S.C. 371.

BACKGROUND

On 28 September 1999, applicants filed international application PCT/JP99/05273 designating the United States only and claiming priority to a Japanese patent application filed 28 September 1998. A Demand for the international preliminary examination was not filed. Accordingly, the twenty-month period for entering the national stage of the United States expired at midnight on 28 May 2000.

On 26 May 2000, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, the basic national fee. Applicants did not submit a copy of the international application with these documents.

On 27 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee must be provided. The declaration provided on 26 May 2000 identified the first inventor differently than is recorded on the international application.

On 07 May 2002, applicants filed a response to the questions raised in the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, a declaration by a Japanese/English translator.

On 26 July 2002, the International Bureau (IB) transmitted a copy of the international application, PCT/JP99/05273, to the USPTO.

DISCUSSION

35 U.S.C. 371 *National stage: Commencement*, states, in part:

- (a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States . . .
- (c) The applicant shall file in the Patent and Trademark Office
 - (2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;
- (d) . . . The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. **Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable.** (Emphasis added).

In the above-captioned national stage application, neither the IB nor the applicant submitted a copy of the international application by the date of commencement of the national stage, *i.e.*, 28 May 2000. The IB verified that they did not transmit a copy of the underlying international application to the USPTO until 26 July 2002.

CONCLUSION

For the reason discussed above, the above-captioned application is hereby **ABANDONED**.

It is noted that applicants' explanation for the different translation of the Chinese characters in the co-inventors' names would be sufficient to meet the requirements of section 201.03 of the MPEP.

RECOMMENDATION

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for mailing of a Notification of Abandonment (Form PCT/DO/EO/909).



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